

REMARKS

The Official Action of July 9, 2008, has been carefully reviewed. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

The claims have been amended to be directed to the elected invention. For convenience in entry of the amendment, the claims have been canceled in their entirety and presented as new Claims 48-57. Support for this amendment is found in the specification, e.g. at page 9, line 12 to page 10, line 34; and the claims of the application as filed.

Claims 48-57 are pending in the application.

2. Claim Objections

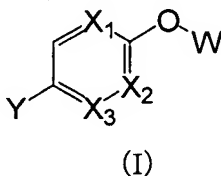
The Examiner was concerned regarding informalities in the claims. As requested by the Examiner, such terminology has been corrected.

3.,4. Claim Rejections - 35 U.S.C. § 112, First Paragraph

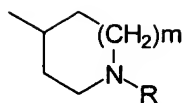
Claims 35-44 and 46-47 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement.

The Examiner was concerned regarding the variables within the definition of the group R. The Examiner stated: "Applicants only provide support for compounds where the variable R is phenyl, O-phenyl, naphthyl, quinolinyl," It appears that the Examiner intended to refer to such compounds wherein the variable Y bears such substituents, rather than the variable R.

Applicants note that in the formula (I), Y is the substituent on the 5-position of the pyrimidine ring:



and that R is the substituent on the cycloalkylamino group W of the formula (II)



(II)

With reference to the structures of the specific examples (e.g. Example 1, on page 73 which bears a cyanophenyl group as "Y" at the 5-position of the pyrimidine), Applicants believe that the Examiner intended to refer to the exemplified compounds wherein the variable Y is as recited (rather than the variable R), and will respond accordingly.

Applicants respectfully assert that the specification fully enables such claims and that the representative examples provide appropriate guidance for practicing the claimed invention without undue experimentation.

Applicants note that the specification provides detailed guidance regarding the scope of substituents that may be employed at the Y position. Nevertheless, in the interest of compact prosecution, the claims have been amended as requested by the Examiner without prejudice.

Accordingly, the rejection of Claims 35-44 and 46-47 under 35 U.S.C. § 112, first paragraph, for lack of enablement should be withdrawn.

5.,6. Claim Rejections - 35 U.S.C. § 102 (e)

Claims 35-38 and 45-47 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Marino et al. (WO 2005/097111, published October 20, 2005, filed March 22, 2005, claiming priority to 60/561,188, filed April 9, 2004).

Applicants respectfully traverse this rejection and submit that Marino et al. is not an effective reference under 35 U.S.C. § 102 (e). The present application is fully entitled to the benefit under 35 U.S.C. § 371 of PCT Application No. PCT/JP2004/009272, filed June 24, 2004, and priority under 35 U.S.C. § 119 from Japanese Application No. JP2003-184879, filed June 27, 2003. The Official Action of May 3, 2007, confirmed that the certified copies of the priority documents have been received by the Office.

Applicants note that in the Official Action of July 11, 2007, the Examiner made a comparable rejection of previous Claims 20-25 and 30-33, and that Applicants fully addressed this rejection in their response dated October 9, 2007.

In their previous response to this rejection dated October 9, 2007, Applicants submitted an English language translation of Japanese Application No. JP2003-184879 (filed June 27, 2003) accompanied by a statement that the translation of Japanese Application No. JP2003-184879 is accurate, in accordance with 37 CFR. § 1.55(a)(4). As Applicants previously noted, the compound 2-(1-cyclopentylpiperidin-4-yloxy)-5-(4-cyanophenyl)pyrimidine is fully supported in Japanese Application No. JP2003-184879 and is disclosed as the title compound of Example 1 on page 83.

The PAIR record for the subject application indicates that such English language translation of Japanese Application No. JP2003-184879 and the statement that the translation is accurate were received by the Office on October 11, 2008. If the Examiner requires an additional copy, Applicants would gladly provide another copy upon request.

Accordingly, the rejection of Claims 35-38 and 45-47 under 35 U.S.C. § 102(e) as being anticipated by Marinio et al. is untenable and should be withdrawn.

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

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